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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|---|-------------|-------------------------|-------------------------------|------------------|
| 10/529,187  | 03/24/2005  | Mario Pollegato Moretti | 268435US6PCT                  | 4422             |
| 22850   | 7590        | 06/12/2007              |                               |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                         | EXAMINER<br>KAVANAUGH, JOHN T |                  |
|   |             |                         | ART UNIT                      | PAPER NUMBER     |
|   |             |                         | 3728                          |                  |
|   |             |                         | NOTIFICATION DATE             | DELIVERY MODE    |
|   |             |                         | 06/12/2007                    | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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**Office Action Summary**

Application No.

10/529,187

Applicant(s)

POLEGATO MORETTI, MARIO

Examiner

Ted Kavanaugh

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-23 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-23 and 27-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 17-23,27-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17 and 32, the phrase "a tread ...with at least one through macroperforation at said at least one preset macroportion....wherein said at least one through macroportion of said tread exposes said supporting layer to an out side portion of said tread and said at least one preset macroportion of said supporting layer having said area on the order of at least one square centimeter" is not clear or understood. How is the macroperforation at said at least one preset macroportion? Also, the "said at least one through macroportion of the tread" lacks proper antecedent bases. Also the support layer having an area on the order of at least one square centimeter has already been recited in lines 3-4 of claim 17 and 4-5 of claim 32. The examiner is guessing applicant is trying to claim the support layer has an area of at least one square centimeter and this area is exposed through a tread at through a macroperforation. However this is not even claimed. The support layer having a "on the order of at least one square centimeter" is only being claimed. All shoes which have a support layer would appear to have at least a square centimeter. It is not clear why applicant is claiming this "square centimeter".

In claim 17 and 32, the phrase "preset macroportion" is unclear How is it preset? The scope of this term is not clear.

Claims 33 and 34 are indefinite. The phrase "wherein said at least one through portion of the tread" is unclear and indefinite. The tread having a "through portion" has not been claimed.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17,18,20-21,23,27-34 as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/14326 (Polegato).

Polegato teaches a waterproof and breathable sole as claimed including a support layer (106) made out of felt, a membrane (105), a tread (103) as claimed except for the tread made out of plastic. The support layer of Polegato has at least one area of at least one square centimeter. The support layer (106) has areas that are exposed through the holes (macroperforations or through portions) of the tread (103). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the tread of Polegato out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See figure 3, which shows each of the layers having perforations or preset macroportion's as claimed.

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 17 above, and further in view of US 6477789 (Cheng).

Cheng teaches providing each of the apertured layers with a mesh layer on top and/or bottom to permit air to pass through freely; see col. 3, lines 8-32. Therefore, it would have been obvious to provide the membrane as taught above with a mesh layer there above, as taught by Cheng, to permit air to pass through freely.

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 21 above, and further in view of US 6508015 (Rauch).

Rauch teaches a breathable sole wherein the tread (outsole) has substantially one single large through macroperforation that affects substantially all of the sole of the foot; see figures 2 and 3 which has substantially one single large opening in the bottom of the outsole to enhance breathing of the sole. It would have been obvious to provide the tread as taught above with one single large through macroperforation, as taught by Rauch, to permit the shoe to breath.

#### ***Response to Arguments***

6. Applicant's arguments filed 5-21-2007 have been fully considered but they are not persuasive.

Applicant argues Polegato lacks several features.

In response, see the rejections above wherein many of the features have been given an indefinite rejection and/or explained in detail in the art rejection above.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).


In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300

Art Unit: 3728

**(FORMAL FAXES ONLY).** Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
June 4, 2007